

### **REMARKS**

This paper is filed in reply to the Office Action mailed October 29, 2010. Claims 1 and 3-19 are pending in the application. Claim 2 is cancelled. Claims 19 and 20 are new. No new matter is added.

Claims 1, 3-6, 8-10, 12, 15, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,171,313 (“Salyer”) in view of U.S. Patent No. 5,928,287 (“Keller”). Applicants traverse the rejection.

Claim 1 claims an instrument for positioning a cup component of an orthopaedic joint prosthesis, the cup component having a mouth and an inner surface with a circumferential groove, the instrument comprising:

a shaft having a shaft axis and a distal end;

a housing attached to the distal end of the shaft, the housing extending from the shaft transversely relative to the shaft axis, the housing comprising a base plate;

at least two flange portions carried on the shaft, each of the at least two flange portions being configured to move relative to the base plate in a direction transverse to the shaft axis between an in-use position, where at least a portion of each of the at least two flange portions is received in the groove of the cup component, and a retracted position where the at least a portion of each of the at least two flange portions is moved towards the shaft axis so as to allow the cup component to be released from the instrument; and

***a spring element disposed between the at least two flange portions and the axis of the shaft, the spring element biasing each of the at least two flange portions towards the in-use position.***

Applicants highlight the last element of claim 1 as Applicants submit that at least that element is not taught by any of the cited references. As shown in Figure 3, reproduced below, element 39, called out as an o-ring in the specification, is shown in cross section as extending circumferentially about the shaft axis, and positioned between two flange portions 36. Spring

element 39 biases *each* of the at least two flange portions towards the in-use position. That is, one spring element 39 biases *each* of the flange portions 36.

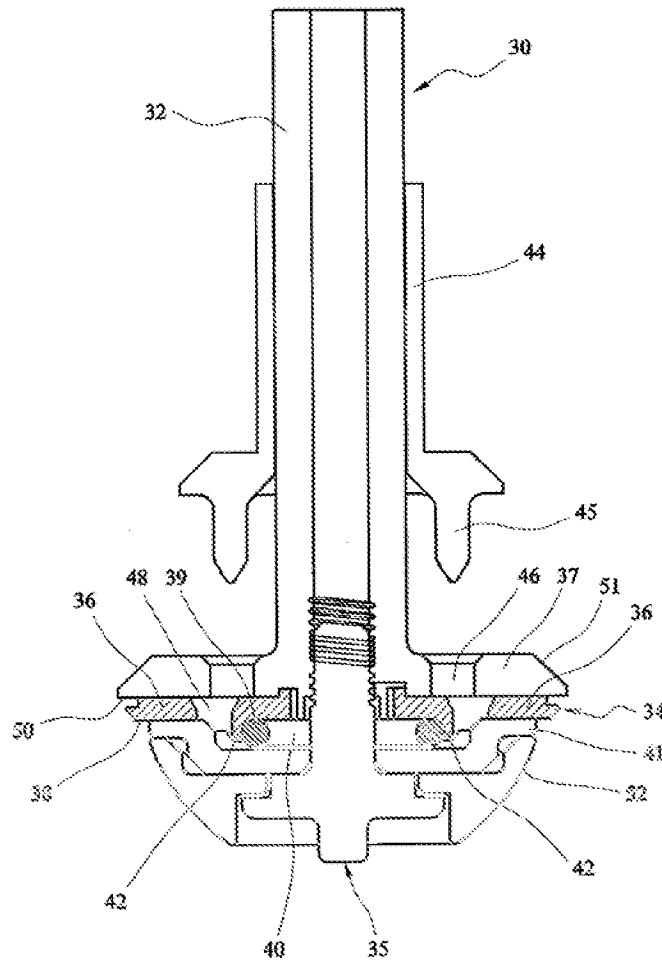


FIG. 3

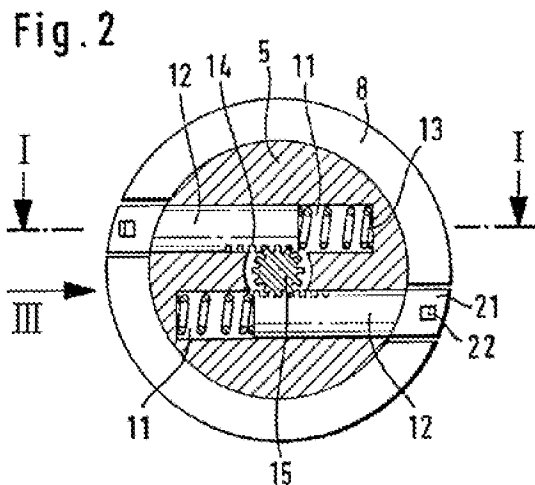
The Examiner cites the combination of Salyer and Keller as rendering claim 1 unpatentable. As admitted by the Examiner, Salyer fails to disclose

the use of at least two flange portions carried on the shaft, each being configured to move relative to the base plate in a direction transverse to the shaft axis and being biased to an in-use position by a spring element disposed between the at least two flange portions, *the spring* biasing the at least two spring portions into the in-use position.

Office Action, page 4. As the Examiner recognized, Salyer failed to disclose an instrument where the spring biases the at least two [flange] portions into the in-use position". Note the use of the singular spring to bias at least two flange portions. The Examiner cites Keller as disclosing two flange portions being biased by one spring:

Keller discloses the use of at least two flange portions (12, figures 1-4) carried on the shaft (3/16, figure 1), each being configured to move relative to the base plate (5, figures 1-3) in a direction transverse to the shaft axis (10, figure 1, column 4, lines 3-56), *a spring element* (13, figures 1-2) biasing the at least two flange portions into the in-use position (column 4, lines 3-19) to permit balanced locking forces (column 2, lines 59-61).

Office Action, page 4. Note again the singular spring element cited as element 13. As is shown clearly in Figure 2 of Keller, reproduced below, each of the flange portions 12 are biased by a separate spring element 13. The specification of Keller makes this relationship clear as well.



As described at column 4, lines 3-7:

In the instrument head there are two bores 11 which lie parallel, with their midpoints symmetrical to each other, in a plane running perpendicular to the midline 10, and which *each* contain a slide piece 12 which is forced towards the outside by a spring 13.

Note that each bore 11 contains a slide piece 12, and each of the slide pieces 12 is forced towards the outside by a spring 13. This is made even clearer in the description which follows, the description regarding how the spring force is countered by the action of a pinion 15:

By actuating the actuating member 4 in the direction of the arrow shown in FIG. 4, the pinion is turned so that the slide pieces 12 are drawn back into the instrument head counter to the action of the *springs 13*. When the actuating member 4 is released, these parts take up the end position represented in FIG. 2.

Keller, col 4:14-17. The pinion, shown above in Figure 2 as element 15 is used to counter the bias of the first spring 13, which biases a first slide piece 12 and a second spring 13, which biases a second slide piece 12. Keller goes onto describe the function of springs 13:

The cup then sits securely on the instrument because the hooks 23 are locked in their holding position by the springs 13. The inclination of the bores 24 and the force of the springs 13 can be readily dimensioned ....

Keller, col 4:40-43. In sum, Salyer fails to describe two flange portions and Keller fails to show a single spring that biases two flange portions. In each case, Salyer and Keller describe a one-to-one correspondence between flange portions and springs. As such, each fails to describe at least one element of the claimed invention of claim 1: a spring element disposed between the at least two flange portions and the axis of the shaft, *the spring element biasing each* of the at least two flange portions towards the in-use position. Thus, even if one skilled in the art would combine Salyer and Keller, that combination would not render the claimed invention obvious. Applicants request the withdrawal of the rejection for the foregoing reasons.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer in view of Keller in view of U.S. Patent Application Publication No. 2005/0131420 ("Techiera").

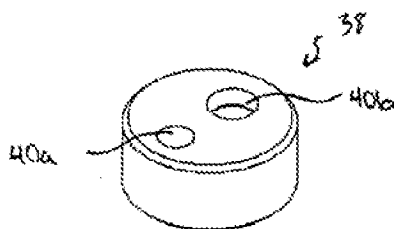
Applicants traverse the rejection. The Examiner cites Techiera for the proposition that an o-ring is a known substitute for a coil spring:

Salyer in view of Keller disclose the claimed invention except that spring is a coil spring instead of an O-ring. Techiera et al. shows that an o-ring is an equivalent structure known in the art (§53). Therefore, because these two springs were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the coil spring of Salyer in view of Keller for the o-ring of Techiera et al.

Office Action, page 8. Thus, based on paragraph 53 of Techiera, the Examiner posits that an o-ring and a coil spring are equivalents. Only the last sentence of paragraph 53 cites the use of an o-ring:

As previously stated, a portion of the driver shaft 18 extends through the retainer member 38, which is thus effective to maintain the position of the driver shaft 18 with respect to the elongate shaft 12 by preventing longitudinal movement, yet allowing rotational movement, of the driver shaft 18. This can be achieved using, for example, an *o-ring* (not shown) that is disposed within the second bore 40b, or by providing other mechanisms such as, for example, pins, *spring* clips, and/or deflectable rings/arms.

**Fig. 5**



Note that there is no teaching that a “coil spring” is equivalent to an o-ring. This particular application states that one can use an o-ring, though it is not shown, to prevent a shaft that would extend through bore 40b from moving longitudinally within a shaft but permit the shaft to rotate within the bore. Techiera simply does not discuss a coil spring and Applicants are not sure how one would use a coil spring to achieve such an end result. Even if a coil spring could be used to

achieve such a result in the application described in Techiera would not render coil springs and o-rings interchangeable for any application. Applicants submit that the Examiner has failed to make a prima facie showing of obviousness with respect to the rejection of claim 7, and request withdrawal of the rejection.

Claims 11, and 13-14, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer in view of Keller in further view of U.S. Patent No. 5,486,181 ("Cohen"). Claims 16-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer in view of Keller in view of U.S. Patent No. 4,023,572 ("Weigan"). Applicants traverse the rejections. Applicants submit that claims 11, 13, 14, 16 and 17 each depend directly or ultimately from independent claim 1, which, as described above, is patentable over the combination of Salyer and Keller. As a result, claims 11, 13, 14, 16 and 17 are patentable for at least this reason. Applicants request withdrawal of the rejections.

Applicants have added new claims 19 and 20 to further define the invention. Claim 19 depends from claim 1 and claims that the spring element is disposed circumferentially about the shaft axis. Claim 20 also depends from claim 1 and claims that the at least two flange portions are spaced apart radially with respect to one another relative to the shaft axis. Applicants submit that none of the cited art describes the inventions of claims 19 and 20, and request favorable consideration.

Applicants submit that the application is presently in condition for allowance and request favorable reconsideration and early notice of allowance. If it would speed prosecution, the Examiner is encouraged to contact the undersigned attorney by telephone.

Respectfully submitted,

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Dated: February 28, 2011